

Appl. No.: 10/098,634
Amdt. dated 06/29/2006
Reply to Office action of March 31, 2006

REMARKS/ARGUMENTS

This correspondence is filed in response to the Final Office Action dated March 31, 2006. Applicant notes with appreciation the Examiner's thorough examination of the application as evidenced by the Final Office Action. In response to the Office Action, Applicant has amended the claims to further clarify the present invention. It is respectfully submitted that Claims 1, 11, 12, as amended, are patentable. As such, Applicant respectfully requests reconsideration and allowance of the present claims in light of the following remarks.

112 rejection

In rejecting Claim 1 under 35 USC 112, the Examiner stated that Applicants seem to claim patentability based on "the specific format of a label and its contents", and refer to various labels by using the term "shipping label" in Claim 1.

Applicants respectfully disagree because the Examiner's characterization could be taken to support an overly narrow interpretation of Claim 1. Claim 1 has been amended to clarify that the shipping label must be acceptable by the carrier to deliver the good to said merchant according to said return transaction. Thus, Claim 1 requires a label that will enable the carrier to return the good, but is not further limited to any specific format or content. Also, it is respectfully submitted that Claim 1 provides a shipping label that not only facilitates return of goods from a customer to a merchant, but also, due to its inclusion of a unique package tracking identifier, enables any party to the return transaction (e.g., customer, merchant, carrier) to keep track of shipment status of the returned. As such a label is not taught by the art cited against Claim 1, Applicants respectfully submit that Claim 1 does not rely for patentability solely upon "the specific format of a label and its contents." Instead, it is further respectfully submitted that, among other distinctive features, Claim 1 is patentable for providing a multi-functional shipping label as stated above.

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The fact that "shipping label" is itself a broad term does not make its use indefinite. The manner in which it is used in Claim 1 is clear, and thus the Applicants respectfully request that the 112 rejection be reconsidered and withdrawn.

102 & 103 rejections

In rejecting Claims 1, 11 as being anticipated by *Hauser* (US Patent No. 6,536,659) under 35 USC 102(e), the Examiner concluded that a "return authorization shipping label" disclosed in *Hauser* would anticipate the "shipping label" claimed in the present application. (Col. 3, Lines 43-64; Col. 3, Line 65 – Col. 4, Line 15) In particular, the Examiner considered the "Return Merchandise Authorization Number" to be an equivalent of the "package tracking identifier" recited in Claim 1. The Examiner further rejected Claim 12 as being unpatentable over *Hauser* in view of Caminti, Alan, Lyons, Cheryl, United Parcel Service Introduces Advanced Label Imaging System, published by Business Wire on 29 November 2005, sec. 1, page 1 ("ALIS Press Release").

Applicants respectfully disagree because a shipping label as characterized in Claim 1 of the present application is patently distinct from a "return authorization shipping label" as described in *Hauser*. In *Hauser*, the return authorization label is generated by a return processing third party instead of a carrier as in the present application. (Col. 4, Lines 16-19). This return authorization label contains a bar code identifying the merchant authorizing the return, the return address (i.e., address of Returns Online, Inc.) and any other information that is relevant to processing the returned merchandise. (Col. 4, Lines 19-22) There is no disclosure or suggestion in *Hauser* that the return authorization label includes a "package tracking identifier" or anything similar for the customer to keep track of shipment status of the returned merchandise, and no suggestion that the label is of a type acceptable by a carrier to initiate the return shipment. In fact, *Hauser* appears to teach away the possibility of including a "package tracking identifier" or anything similar in the return authorization shipping label, in view of the description that "[i]n addition, Returns Online, Inc. may include either a prepaid United States

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Postal Service Postage Permit or other private shipper forms that can be used by the customer returning the merchandise to facilitate shipment of the merchandise to Returns Online, Inc.” (Col. 4, Lines 24-30). As indicated in *Hauser*, in order to return merchandise, a customer needs additional shipment documents (e.g., Prepaid USPS Postage Permit or private shipper forms) besides a return authorization label. This means, in contrast to the shipping label claimed in the present application, one skilled in the art would not conclude that the return authorization label in *Hauser* is self-sufficient for shipping the returned merchandise. Further, such label does not include a “package tracking identifier” for customers or other parties to the transaction to track shipment of their merchandise as it is being returned.

In light of the above, Applicants respectfully submit that the “return authorization shipping label” disclosed in *Hauser* does not anticipate the shipping label as characterized in Claim 1. Applicants have amended Claims 1, 11 to further clarify the above-mentioned distinctive features of the present invention. For example, Claim 1 is amended by including limitations such as “wherein said package tracking identifier is generated readable by a carrier shipment tracking system for tracking shipment progress of said good to be returned return transaction,” and “generating said shipping label based at least in part on said shipping information and said ~~package tracking identifier~~, said shipping label being acceptable by said carrier to deliver said good to said merchant according to said return transaction and including said package tracking identifier for said customer to track shipment of said good to be returned.” Therefore, it is respectfully submitted that Claims 1, 11, as amended, are patentable over the prior art and in condition for allowance.

In addition, Applicants respectfully request that the rejection of Claim 12 be reconsidered and withdrawn. In response to the Examiner’s comments, Applicants specifically traverse the combinability of the two references, *Hauser* and the ALIS Press Release, because the Examiner did not point out any motivation or suggestion to combine them. Further, for the foregoing reasons, Applicants respectfully submit that Claim 12, which is dependant from Claim

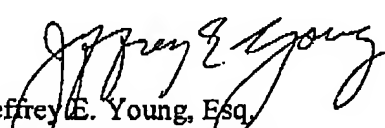
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1, is not anticipated or rendered obvious by either *Hauser* or the ALIS Press Release or both.
Therefore, it is respectfully submitted that Claim 12 is patentable and in condition for allowance.

In light of the above-stated amendments and remarks, Applicants respectfully submit that the present Claims 1, 11 and 12 are in condition for immediate allowance. Thus, it is respectfully requested that the Examiner issue a notice of allowance of the present claims.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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